

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION AND
IS NOT BINDING PRECEDENT OF THE BOARD

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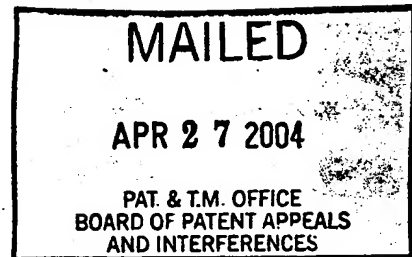
BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

JOHN L. SERNYK and JUAN E. ROMERO LANUZA

Junior Party
(Patent 5,965,755),

v.

LORIN R. DEBONTE
Senior Party
(Application 10/034,698).



Patent Interference No. 105,163

DECISION ON SERNYK PRELIMINARY MOTION 1

I. Background

Sernyk has a filed a document styled SERNYK PRELIMINARY MOTION 1 (Paper 24).

In the preliminary motion, Sernyk moves for judgment under 37 CFR § 1.633(a) on the ground that DeBonte's involved claims 20-72 are unpatentable to DeBonte under 35 USC § 135(b)(1).

DeBonte has filed an opposition ("Debonte Opposition 1", Paper 39).

Sernyk has timely filed a reply ("Sernyk Reply 1", Paper 42).

Having considered each of these documents, along with the supporting exhibits, we find that Sernyk has established by a preponderance of the evidence that DeBonte's involved claims 20-72 are unpatentable to DeBonte under 35 USC § 135(b)(1). Sernyk's Preliminary Motion 1 is granted.

II. Findings of fact

The following findings are supported by at least a preponderance of the evidence.

A. The Parties

The interference was declared on November 20, 2003 (Paper 1).

1. Junior party Sernyk

Junior party Sernyk is John L. Sernyk and Juan Enrique Romero Lanuza.

Sernyk is involved in this interference on the basis of U.S. Patent 5,965,755 (issued October 12, 1999), based on Application 08/374,402, filed January 17, 1995.

Sernyk has been accorded the benefit for the purpose of priority of Application 08/135,105, filed October 12, 1993 (Paper 1, page 4).

The real party in interest is Dow Agriscience, Inc. (Paper 6).

2. Senior party DeBonte

Senior party DeBonte is Lorin R. DeBonte, Willie H.T. Loh and Zhegong Fan.

DeBonte is involved in this interference on the basis of Application 10/034,698, filed December 21, 2001.

DeBonte has been accorded the benefit for the purpose of priority of the following applications (Paper 1, page 3)¹:

Application 09/861,905, filed May 21, 2001;

Application 08/850,279, filed May 5, 1997, now U.S. Patent 6,270,828B1, issued August 7, 2001;

Application 08/290,660, filed August 15, 1994, now U.S. Patent 5,750,827, issued May 12, 1998;

Application 08/140,205, filed November 12, 1993; and

Application 07/767,748, filed September 30, 1991.

The real party in interest is Cargill, Inc. (Paper 11).

B. The Counts

The interference involves two counts.

Count 1 reads:

An oil from the seed of *Brassica napus* or a canola oil, said oils having an oleic acid content of 71.4% to about 72.6% and a linolenic acid content of about 1.3% to 2.1%.

Count 2 reads:

An oil produced from the seed of *Brassica napus* or a canola oil, said oils having an (oleic acid + linoleic acid)/linolenic acid ratio value of from about 41.2 to 51.8 and a linoleic + linolenic acid content ranging from 16.3 to 18.7.

¹ To date, there has been no occasion to determine whether DeBonte is entitled to a filing date of 30 September 1991 under 35 USC § 120. See *Furman v. Cheng*, 59 USPQ2d 1668 (Bd. Pat. App. & Int. 2001) and *Cromlish v. D.Y.*, 57 USPQ2d 1318, 1319 (Bd. Pat. App. & Int. 2000) (difference between benefit for priority and benefit to overcome prior art reference explained).

C. The Claims of the Parties

1. Sernyk

Claims 1, 2 and 9-11 of the Sernyk '755 patent are involved in this interference.

Claims 1, 2 and 9 are designated as corresponding to Count 1.

Claim 1 reads:

Oil from the seed of *Brassica napus*, said oil having an oleic:linolenic acid ratio value of from about 34.0 to about 55.3.

Claims 2 and 9 depend from claim 1.

Claims 10 and 11 are designated as corresponding to Count 2.

Claim 10 reads:

Oil produced from the seed of *Brassica napus*, said oil having an (oleic + linoleic)/linolenic acid ratio value of from about 41.2 to about 63.9, and a combined linoleic + linolenic acid content of no more than about 18.7.

Claim 11 depends from claim 10.

2. DeBonte

Claims 20-72 of the DeBonte '698 application are involved in this interference.

Claims 20-58, 61, 62, 65, 66, 69 and 70 are designated as corresponding to Count 1.

Claim 20 reads:

A canola oil having an oleic acid content of about 66.3% to about 72.6% and an α -linolenic acid content of less than about 7%.

Claims 21-28 and 56-58 depend from claim 20.

Claim 29 reads:

Oil produced from the seed of *Brassica napus*, said oil having an oleic acid content of about 66.3% to about 72.6% and an α -linolenic acid content of less than about 7%.

Claims 30-37, 61 and 62 depend from claim 29.

Claim 38 reads:

A canola oil having an oleic acid content of about 66.3% to about 72.6% and an α -linolenic acid content of less than about 7%, said oil produced from seed of progeny of a *Brassica napus* variety designated IMC 01, deposited as ATCC 40579.

Claims 39-46, 65 and 66 depend from claim 38.

Claim 47 reads:

A canola oil having an α -linolenic acid content of less than about 7%, said oil produced from seed of progeny of a *Brassica napus* variety designated IMC 01, deposited as ATCC 40579.

Claims 48-55, 69 and 70 depend from claim 47.

Claims 59, 60, 63, 64, 67, 68, 71 and 72 are designated as corresponding to Count 2.

Claim 59 reads:

The oil of claim 20, wherein said oil has an (oleic acid + linoleic acid)/ α -linolenic acid ratio value ranging from 18.7 to 51.8, and a linoleic + α -linolenic acid content ranging from 16.3 to 29.8%.

Claim 60 reads:

The oil of claim 20, wherein said oil has an (oleic acid + linoleic)/ α -linolenic acid ratio of 43.5 and a linoleic + α -linolenic acid content of 16.4%.

Claims 63 and 64 depend from claim 29 but are otherwise identical to claims 59 and 60, respectively.

Claims 67 and 68 depend from claim 38 but are otherwise identical to claims 59 and 60, respectively.

Claims 71 and 72 depend from claim 47 but are otherwise identical to claims 59 and 60, respectively.

D. Subject Matter of the Invention

The invention, in general, relates to a canola oil or an oil from the seed of *Brassica napus*.

The term *canola oil* refers to an oil obtained from a low erucic acid, low glucosinolate rapeseed (DX 1011).

Rapeseed comes from various species belonging to the genus *Brassica*, which includes *Brassica napus* (DX 1016).

Canola oil contains, *inter alia*, oleic acid ($C_{18:1}$), linoleic acid ($C_{18:2}$) and α -linolenic acid ($C_{18:3}$) (DX 1004).

The earliest commercially available canola oils contained relatively high levels (8-10%) of α -linolenic acid (DX 1005; SX 2007, p. 2, ll. 1-4)

The first low α -linolenic acid cultivar, Stellar, was registered in 1987 (DX 1005).

E. The Sernyk '755 Patent

The Sernyk '755 patent is directed to a variety of *Brassica napus* designated AG019, which is said to contain about 71-78% oleic acid and no more than about 3% α -linolenic acid (SX 2015).

The parent lines of AG019 are said to be AG013 and BN0010 (SX 2015, col. 7, ll. 1-2).

AG019 is said to have improved oxidative stability over standard canola oil (SX 2015, col. 10, ll. 62-64).

Oil produced from the seed of AG019 is said to have an oleic/linolenic acid ratio of from 34.0 to about 55.3 and an (oleic acid + linoleic acid)/linolenic acid ratio of from about 41.2 to about 63.9 (SX 2015, col. 4, ll. 7-11).

The oleic/linolenic acid and (oleic acid + linoleic acid)/linolenic acid ratios are said to be indicative of oxidative stability of an oil (SX 2015, col. 9, ll. 58-61).

F. The DeBonte '279 and '698 Applications

DeBonte Application 10/034,698 is a continuation of Application 08/850,279, which is a divisional of Application 08/290,660.

1. IMC 01

The DeBonte '279 and '698 Applications are directed to a variety of *Brassica napus* designated IMC 01.

An Application for Plant Variety Protection Certificate on IMC 01 was filed on March 18, 1991 by E.I. du Pont de Nemours and Company² (SX 2002). In Exhibit B of the Application, IMC 01 is said to have 64.7% oleic acid, 23.3% linoleic acid and 2.1% α -linolenic acid

Table I of the DeBonte '279 and '698 Applications (SX 2018 & 2007) describes the fatty acid composition of IMC 01 over five generations as follows:

DATE OF ANALYSIS	PERCENT COMPOSITION				
	C _{16:0}	C _{18:0}	C _{18:1}	C _{18:2}	C _{18:3}
11/87	4.1	1.9	64.1	25.7	1.9
8/88	4.6	2.3	72.6	14.4	2.0
1/89	4.9	1.5	60.4	25.8	2.5
4/89	4.8	1.8	64.3	21.4	4.0
10/89	4.3	2.1	64.1	24.8	2.0

An Application for Plant Variety Protection Certificate on IMC 130 was filed on March 9, 1993 (SX 2040). The applicant listed is Cargill Incorporated. IMC 130 is said to be a cross of IMC 129 and IMC 01 (SX 2040, Exhibit A). In Exhibit B of the Application, IMC 01 is said to have 64.7% oleic acid, 23.3% linoleic acid and 2.1% α -linolenic acid.

In a publication titled *Sources of Oilseeds with Specific Fatty Acid Profiles*, in Development and Processing of Vegetable Oils for Human Nutrition 87, 87-96 (Roman

²A Plant Variety Protection Certificate (No. 9100138) for IMC 01 was granted on March 31, 1993. SX 2003. Cargill acquired the entire right, title, and interest to the IMC 01 plant line via an assignment from du Pont executed on November 30, 1994. SX 2004.